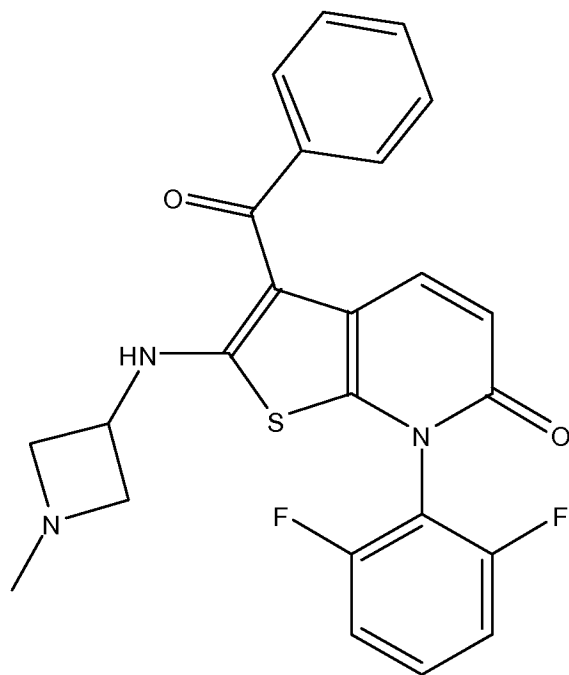


## REMARKS

In the Action of March 3, 2009, the Examiner has required restriction between “Group I, the instances wherein  $R^1$ - $R^3$  are non-heterocyclic groups; Group II, the instances wherein one of  $R^1$ - $R^3$  represents an additional heterocycle; and Group III, claims 11-25 drawn to multiple uses.” The Examiner also has required an election of species for purposes of examination.

Applicant elects for purposes of examination the compound of Example 228, 3-Benzoyl-7-(2,6-difluorophenyl)-2-[(1-methylazetidin-3-yl)amino]thieno[2,3-b]pyridin-6(7H)-one, the structure of which is reproduced below.



The restriction as to Group III is acknowledged. Claims 11-25 relating to the Group III invention are now withdrawn.

The restriction as to Groups I and II is respectfully traversed on the basis that at least independent claim 1 is a generic or linking claims. Accordingly, pursuant to MPEP §§ 803.02 and 809, the applicants respectfully request the Office expand examination of

the claims to the non-elected portion of the generic claims, which, in the present instance, is the full scope of all claims, other than the Group III claims, presently withdrawn.

As stated in MPEP § 809,

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application to one would be proper, but presented in the same case are one or more claims (generally called ‘linking’ claims) which, if allowable, would require rejoinder of the otherwise divisible inventions. . . . The most common types of linking claims which, if allowable, act to prevent restriction between inventions that can otherwise be shown to be divisible, are (A) genus claims linking species claims . . . . The linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement must be withdrawn. Any claim(s) directed to the non-elected invention(s), previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.

M.P.E.P. § 809 (emphasis added).

The present application presents Markush claims, and the proper procedure for examining such claims is described in M.P.E.P. § 803.02:

A Markush-type claim may include independent and distinct inventions. . . . In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. . . . Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

\* \* \*

On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The examination will be extended to the

extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicants hereby reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

It is respectfully requested that prosecution proceed on the merits. The Examiner is invited to contact the undersigned applicant's representative if it is believed that such communication would further the progress of the application.

Respectfully submitted,

Date: April 3, 2009

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